

REMARKS

Claims 1-18 and 20 are pending. Applicants elect with traverse Group I (claims 1-18 and 20) and SEQ ID NO: 1 for examination on the merits. It is noted that all of the pending claims are generic for SEQ ID NOS: 1 to 3. Applicants reserve the right to prosecute non-elected subject matter in a further patent application.

Notwithstanding the above election, reconsideration of the restriction requirement is requested because examination of Groups I to III would not constitute a serious burden. Although the inventions identified by the Examiner are separately patentable, the need for compact prosecution and the public interest would be served by examination of all claims in a single application. Thus, the claims as directed to SEQ ID NOS: 2 and 3 should not be withdrawn from consideration.

Applicants also disagree with the allegation in the Action that the pending claims lack unity of invention, and therefore belong to different groups of inventions. Although they agree with the Examiner's conclusion that the inventions are separately patentable, this traversal is based on the pending claims being so linked as to form a single general inventive concept under PCT Rule 13.1. As shown in claim 10, SEQ ID NOS: 1 to 3 are not identical but they clearly have *similar* structures. In contradiction to the allegation made in the Office Action at pages 2-3, the alternative staple oligonucleotides do share a common structure (i.e., a significant structure shared by all of the alternatives) described in claim 1. In particular, they have *related* nucleotide sequences. Thus, the pending claims should be examined together in this application.

It was alleged in the Office Action that the inventions listed as Groups I to III do not relate to a single general inventive concept because they lack a special technical feature. While the Examiner admits in the Office Action that SEQ ID NOS: 1 to 3 have a common property or activity (see "the staple oligonucleotides all function as a transcription factor inhibitor" at page 3, emphasis added), it was asserted that a common structure is not present. But as discussed above, the common structure is "a single-stranded oligonucleotide comprising a 5'-end sequence, an intermediate sequence and a 3'-end sequence, the 5'-end sequence having a reverse complementarity with the intermediate sequence, the 3'-end sequence having a reverse complementarity with the intermediate sequence and the intermediate sequence having loops at both ends, the loops each comprising three to ten

nucleotides and not forming a complementary bond intermolecularly” as recited in claim 1. Here, the special technical feature linking the pending claims are the common structures required by claim 1. Thus, Groups I to III are shown to have unity of invention.

Finally, another reason for traversal is that the independent claim is a generic or linking claim for the inventions listed as Groups I to III. Thus, examination should proceed under the provisions of M.P.E.P. § 809. SEQ ID NOS: 1 to 3 are species of the genus of staple oligonucleotides defined by claim 1.

Accordingly, for all of the reasons explained above, a finding that the claims lack unity of invention and this restriction requirement are improper. Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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